

REMARKS

This Amendment and Response is prepared in response to the restriction requirement set forth in the Office action mailed on 1 March 2006 (Paper No. 0206).

By this Amendment, claims 1 through 9 and 11 through 20 have been amended. Thus, claims 1 through 20 are pending in the application.

In the Office action mailed on the 3rd of March 2006 (Paper No. 0206), the Examiner has imposed a Requirement for Restriction under 35 U.S.C. §121 and 37 CFR §1.142 between:

- **Group I** covered by claims 1 through 11, drawn to organic electroluminescent devices, classified in class 313, subclasses 506; and
- **Group II** covered by claims 12 through 20, drawn to methods of fabricating an organic electroluminescent devices, classified in class 445, subclasses 24.

Applicant respectfully traverses the election requirement imposed in the Office action, but provisionally elects, with traverse, Group II. According to Paper No. 0206, claims 12 through 20 are within the elected Group II. With entry of the foregoing amendments, linking claims 9 and 11, together with claims 12 through 20, are within the elected Group II

Applicants object to the imposition of this requirement for restriction requirement on the following grounds.

First, the subject matter of the two groups overlap. In addition, the mandatory fields of search of both of these groups are substantially coextensive because Group I covered by claims 1 through 8 and 10 drawn to Class 313, subclasses 506 ¹ are breakouts of solid-state type variable devices with electron streams, subclass 107.5 and subclass 498, while Group II covered

¹ Applicant notes that the Examiner's classification appears to be inaccurate, and the subclass should be 504.

by claims 9 and 12 through 20 are directed according to the Examiner's classification, display or gas panel making within the electric lamp or space discharge component or device manufacturing, class 445, subclass 24. In actuality however, recently issued U.S. Patent Nos. 7,001,678 directed to crosslinked polymer blends, 6,998,789 directed to organic electroluminescent devices within class 313, subclass 504 included both composition and device or method and device claims, while recently issued patent Nos. 7,008,282 for a method for eliminating materials, 7,004,812 directed to paste, display member, and process and 6,987,358 directed to glass for covering electrodes, included both method and device claims, while 6,988,922 for methods for manufacturing electron-emitting device included both method, device and composition of matter claims. A careful review of recent issues classified in both classes conclusively establishes that the claims are directed in other recent issues to either devices or to methods of manufacturing those devices. There is in recent U.S. practice, no demarkation between the subject matter of the pending claims and classes 313 and 445. Consequently, a search of either Group I or Group II has a mandatory field encompassing subclasses in both classes 313 and 445; in other words, if mandatory fields of search for both groups are coextensive.

Second, the Examiner asserts that "the product as claimed can be made by another materially different process such as comprising the steps of forming anode electrodes of R unit pixel by subsequent vapor deposition of first and second anode electrodes, then deposition of organic thin film layer of R unit pixel by ink-jet method and then forming anode electrodes of G and B unit pixels by vapor deposition of first and second anode electrodes" This ignores the fact that the subclasses within process class 445 are generally defined by structural elements, as are the subclasses within class 313. Consequently, the process of manufacturing is irrelevant

to the classification. The Examiner's reasoning suggests and inferences that the fields of search are distinct. This inference is unsupported by the evidence of record; consequently there is no basis for asserting that the subject matter of these five groups is either independent or distinct. Thus, the mandatory fields of search necessarily overlap and are substantially coextensive for all three of the groups of claims, and therefore the restriction requirement serves no purpose other than to impose an undue burden and unnecessary expense upon the Applicants (*see* MPEP §802.01, §806.04, §808.01). There would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits. Withdrawal of the requirement is therefore respectfully urged.

Third, rising to level of a *serious* burden is seriously suspect, especially in light of the generic claims involved. It appears that the restriction requirement is being imposed here merely for administrative convenience, and such a basis for imposition of a restriction requirement has been prohibited in previous decisions of the Commissioner.

As specifically stated in *Manual of Patent Examining Procedure*, 8th Edition, Revision 3 (August 2005), §803, in imposing a restriction requirement, the Examiner must show that: (A) the inventions are independent (*see also* MPEP §802.01, §806.04, §808.01) or distinct as claimed (*see further* MPEP §806.05 - §806.05(i)); **and** (B) there will be a **serious burden** on the Examiner if the restriction requirement is not imposed (*see* MPEP §803.02, §806.04(a) - §806.04(i), §808.01(a), and §808.02). It is respectfully submitted that in an examination of the above-captioned application, there would **not be a serious burden** upon the Examiner in searching the invention of Groups I, II and III because the Examining staff has failed to show any type of burden, much less a serious burden, in the absence of a restriction requirement. In particular, not only has the Examiner failed to show that the search would impose a burden, but

also the Examiner has failed to show that any burden would rise to the level of a serious burden. As stipulated in MPEP §803, if the search can be made without serious burden, the Examiner **must examine the application on the merits**, even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in the Office action mailed on 3 March 2006 (Paper No. 0206) and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in the next Office action, the restriction requirement can not be made final according to MPEP §706.07. Therefore, there would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

Fourth, MPEP §806.03 states that:

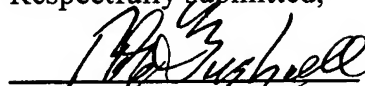
“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween **should never be required**. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition” (emphasis supplied).

Why, then has this prohibition been violated in the above-captioned application where a single embodiment has been disclosed? That fact that Applicant’s claims are very broad in scope, and cover a plethora of implementations of the principles of Applicant’s inventions, is not a basis for violating this prohibition against restriction. Withdrawal of this requirement is therefore respectfully urged.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this response.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. E. Bushnell", is written over a horizontal line.

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